

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 287-322, 324, 326-361, 374-403, 416-432, 434-442, 446-491, 507-517, 553-596, 598-607, and 623-632 are pending in the application, with claims 287, 300, 319, 340, 351, 374, 389, 416, 431, 446, 459, 476, 507, 533, 565, 580, 581, and 595 being the independent claims. Claims 362 to 373, 404 to 415, 608, 611 to 619, and 622, in addition to previously canceled claims, are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Applicants reserve the right to pursue the subject matter of these claims in related applications. Amendments are requested to claims 507, 553, 554, 580, and 582. The amendments to claims 580 and 582 are to correct inadvertent typographical errors. Support for the amendments may be found, for example, in the specification at page 30, line 3. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Prior Rejections under 35 U.S.C. §§ 102(e) and 103***

Applicants thank the Examiner for considering Applicants' arguments and subsequently withdrawing the rejections under 35 U.S.C. §§ 102(e) and 103. *See* the 08-06-04 office action at page 2.

***Double Patenting Rejection***

The Examiner has rejected the pending claims under the judicially created doctrine of obviousness type double patenting over claims 1 to 48 of U.S. Patent No. 6,743,625. *See* the 06-08-04 office action at pages 2-3. Applicants respectfully disagree; however, in the interests of furthering prosecution, and not in acquiescence to the Examiner's rejection, Applicants submit herewith a Terminal Disclaimer To Obviate a Double Patenting Rejection over a Prior Patent. Accordingly, Applicants respectfully request that the double patenting rejection be reconsidered and removed.

***Enablement Rejections under 35 U.S.C. § 112***

(a) The Examiner has rejected claims 553-564 under 35 U.S.C. § 112, first paragraph for allegedly lacking enablement. Applicants respectfully traverse this rejection and maintain that claims 553-564, as previously presented, are fully enabled. More particularly, Applicants strongly disagree with the Examiner's allegation that "[w]hile the skilled artisan could use an antibody that binds SEQ ID NO:2, it would require undue experimentation to use a polypeptide bound by the antibody if that polypeptide did not share the property of inducing apoptosis or binding TRAIL as disclosed for SEQ ID NO:2." *See* the 06-08-04 office action at page 4, lines 5-7. Nevertheless, solely to advance prosecution, and not in acquiescence to the Examiner's

rejection, Applicants have amended claim 553 to recite that the claimed polynucleotide encodes a polypeptide which inhibits apoptosis. Support for this amendment may be found, for example, in the specification at page 32, lines 26 to 32, page 36, line 30 to page 37, line 6, and Example 6, page 53 line 20 to page 54, line 13. Applicants reserve the right to prosecute the subject matter of previously pending claims 553-564 in related applications.

Based on these remarks, Applicants respectfully request that the enablement rejection of claims 553-564 under 35 U.S.C. § 112, first paragraph be reconsidered, and further that it be withdrawn.

(b) The Examiner has rejected claims 362-373 and 404-415 under 35 U.S.C. § 112, first paragraph for allegedly lacking enablement. Solely to advance prosecution, and not in acquiescence to the Examiner's rejection, Applicants have canceled claims 362-373 and 404-415. Applicants reserve the right to pursue these claims in related applications. Accordingly, Applicants respectfully request that the rejection of claims 362-373 and 404-415 under 35 U.S.C. § 112, first paragraph be withdrawn.

(c) The Examiner has rejected claims 507-517, 608, 611-619, and 622 under 35 U.S.C. § 112, first paragraph for allegedly lacking enablement. Applicants respectfully traverse this rejection and maintain that claims 507-517, 608, 611-619, and 622, as previously presented, are fully enabled. However, solely to advance prosecution, and not in acquiescence to the Examiner's rejection, Applicants have canceled claims 608, 611-619, and 622, and have amended claim 507, from which claims 508-517 depend, to recite "[a]n isolated polynucleotide which encodes at least 50 contiguous amino acids of amino acids 1 to 133 of SEQ ID NO:2," which the Examiner has indicated to be fully enabled (*see* the 8-06-04 office action at page 5, lines 10-12). Applicants reserve the

right to prosecute the subject matter of the canceled claims and of previously pending claims 507-517 in related applications.

Based on these remarks, Applicants respectfully request that the enablement rejection of claims 507-517, 608, 611-619, and 622 under 35 U.S.C. § 112, first paragraph be reconsidered, and further that it be withdrawn.

***Written Description Rejections under 35 U.S.C. § 112***

(a) The Examiner has rejected claims 553 to 564 under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement.

Applicants respectfully traverse the Examiner's rejection, and maintain that claims 553-564 as previously presented are fully compliant with the written description requirement. However, solely to advance prosecution, and not in acquiescence to the Examiner's rejection, Applicants have amended claim 553, from which claims 554 to 564 depend, to recite a polynucleotide which encodes a polypeptide at least 90% identical to amino acids 1 to 133 of SEQ ID NO:2, where the polypeptide inhibits apoptosis. Support for this amendment may be found, for example, in the specification at page 32, lines 26 to 32, page 36, line 30 to page 37, line 6, and Example 6, page 53 line 20 to page 54, line 13.

Accordingly, Applicants respectfully request that the written description rejection of claims 553 to 564 under 35 U.S.C. § 112, first paragraph be reconsidered, and further that it be withdrawn.

(b) The Examiner has rejected claims 362-373 and 404-415 under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. Solely to advance prosecution, and not in acquiescence to the Examiner's

rejection, Applicants have canceled claims 362-373 and 404-415. Applicants reserve the right to pursue these claims in related applications. Accordingly, Applicants respectfully request that the written description rejection of claims 362-373 and 404-415 under 35 U.S.C. § 112, first paragraph be withdrawn.

### ***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Elizabeth J. Haanes, Ph.D.  
Attorney for Applicants  
Registration No. 42,613

Date: November 8, 2004

1100 New York Avenue, N.W.  
Washington, D.C. 20005-3934  
(202) 371-2600